

REMARKS

Upon entry of the present amendment, claims 6 and 7 will have been canceled, without prejudice and without disclaimer of the subject matter, and claims 1-5 and 8-14 will have been amended to more clearly define the invention. For example, claims 1, 5 and 11 have been amended to further recite, generally, that a law is accepted when a proposed or initial image is determined not to obstruct the legislative objective. Applicant respectfully submits that all pending claims are now in condition for allowance.

In the above-referenced Official Action, the Examiner rejected claims 1-14 under 35 U.S.C. § 112, first paragraph, asserting that the specification does not comply with the enablement requirement. More particularly, the Examiner asserted that the claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. For example, the Examiner stated that it is not clear how the determination of the initial law is performed, and who makes this determination.

With respect to the merits of the rejection, Applicant respectfully submits that the specification is sufficiently enabling with respect to the subject matter of pending claims 1-5 and 8-12. For example, the initial law is determined by an entity responsible for determining laws, such as a representative group, legislative body or one of a plurality of participants. See, e.g., paras. [0059]; [0061]. With respect to determination of the initial image (and the second image) that does not fit in, independent claims 1, 8, 11 and 13 have been amended to

clarify that the plurality of participants (e.g., members of the affected community) provide the images that do not fit in, which are received by the entity responsible for determining the laws. See, e.g., para. [0025]. Also, claims 1 and 8 have been amended to clarify that, when an initial image that does not fit in with the initial law does not obstruct the legislative objective, the initial law is adopted as the law.

With respect claim 3, the Examiner's rejection is moot at least in view of the present amendments. More particularly, claim 3 now recites that determining whether the initial image that does not fit in obstructs the legislative objective is based upon voting by participants through the plurality of user terminals. Likewise, with respect to claim 13, the Examiner's rejection is moot in that Applicant has amended the claim to recite when a final law is determined, i.e., when a scenario is determined not to actually obstruct the objective, a last revised law of the consecutively determined plurality of revised laws is the final law. See, e.g., paras. [0046]; [0054].

Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. § 112, first paragraph.

Also in the above-referenced Official Action, the Examiner rejected claims 1-5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which is regarded as the invention. In particular, the Examiner indicated that she did not know the definitions of "initial image" and "nightmare" (which is not actually recited in the claims), and thus the meaning and scope of the claims are unclear. However,

Applicant respectfully directs the Examiner's attention to the specification, which defines an "initial image that does not fit in with the initial law" and "nightmare" as factual scenarios that result in an unacceptable consequence of implementing a proposed law. See, e.g., paras. [0023]; [0046]. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. § 112, second paragraph.

Also in the above-referenced Official Action, the Examiner rejected claims 1-14, under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner asserted that the results of the invention are not "substantially repeatable," and therefore not patentable subject matter. In support of this proposition, the Examiner cited *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000), in which claims directed to "cold fusion" were rejected as unpatentable subject matter.

However, contrary to the Examiner's assertion, the focus of the test articulated by the Federal Circuit in *Swartz* was on whether a claimed invention was operable, not whether the steps of a claimed process may include subjective input: "The utility requirement of § 101 mandates that the invention be operable to achieve useful results. *Id.* (citing *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 155, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992)) (emphasis added). In other words, the "cold fusion" invention of *Swartz* was "irreproducible" because it was not operable, i.e., it could not be made to work. The decision was not based on a situation in which an invention worked and the results were useful, but some steps of the claimed process required subjective input.

Also, “[t]o violate Section 101 the claimed device must be totally incapable of achieving a useful result.” *Brooktree*, 977 F.2d at 1571, 24 USPQ2d at 1412 (emphasis added). In the present application, the mere fact that certain steps require human input does not render the claimed embodiment “totally incapable” of yielding a useful result. The process itself is operable, repeatable and produces a useful outcome.

Further, Applicant notes that the Examiner has the initial burden of showing the lack of utility of an invention. See, e.g., MPEP § 2164.07. Applicant respectfully submits that, in view of the very case law relied upon by the Examiner, as discussed above, this burden has not been met. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. § 101.

Also in the above-referenced Official Action, the Examiner rejected claims 11-12 under 35 U.S.C. § 102(a) as being anticipated by New Hampshire Tax Policy Analysis System. The Examiner rejected claims 1-5, 8-10 and 13-14 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON, “How Our Laws are Made” in view of the New Hampshire Tax Policy Analysis System. The Examiner rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON in view of EDER (U.S. Patent No. 6,231,205). Applicant respectfully traverses these rejections, at least for the reasons stated below.

With respect to claims 11 and 12, the Examiner asserted that the New Hampshire Tax Policy Analysis System discloses a client/server architecture that

interfaces multiple users to “accurately and quickly determine the effects of both current and proposed State tax policies on New Hampshire residents.” This includes forecasting tax revenues, modifying exemptions or credits, projecting economic impact on different taxpayer groups, comparing different tax policies, etc.

The Examiner specifically stated that the New Hampshire Tax Policy Analysis System only teaches a central processing unit, a server accessed by multiple user terminals and a memory. However, the Examiner did not address the functionality of any of these elements as recited in the claims. For example, the Examiner did not identify any portion of the New Hampshire Tax Policy Analysis System that teaches or suggests presenting an objective of the law to the multiple terminals, receiving an initial law, receiving a proposed image that does not fit in with the objective, presenting the proposed image that does not fit in to the terminals, receiving votes and/or receiving a second law derived from the first law, as defined in the various pending claims.

Accordingly, since the New Hampshire Tax Policy Analysis System does not disclose each and every element of claims 11 and 12, withdrawal of the rejections under 35 U.S.C. § 102(a) based on the New Hampshire Tax Policy Analysis System is respectfully requested.

With respect to the rejection under 35 U.S.C. § 103(a) of claims 1-5, 8-10 and 13-14, the Examiner relied on JOHNSON as the primary reference. JOHNSON was published by the Office of the Parliamentarian of the U.S. House of Representatives and discloses congressional procedures to facilitate a greater

understanding of the federal legislative process. See JOHNSON, p. 1. However, JOHNSON generally describes the political process, and does not teach or suggest the specific steps in formulating a law, i.e., beginning with identifying the objective of the law, as recited in the claims.

For example, to teach presenting an initial image that does not fit in with the initial law and thus potentially obstructing the legislative objective, the Examiner relied on pages 1 and 10 of JOHNSON. However, the cited portions of JOHNSON respectively describe the approval process for a proposal to become law and committee reports on the necessity or desirability of enacting a bill into law. In other words, JOHNSON merely discloses the established political process of a bill becoming a law. JOHNSON does not teach or suggest methodology for substantively analyzing a bill in order to obtain a more desirable final law, e.g., by testing a proposed law against proposed factual scenarios that result in unacceptable consequences of implementing the proposed law, and systematically modifying the proposed law, as needed, to account for the unacceptable consequences (e.g., obstruction of the legislative objective).

Accordingly, withdrawal of the rejections of independent claims 1, 8, 11 and 13 based on any combination including the JOHNSON reference is respectfully requested.

The Examiner relied on the New Hampshire Tax Policy Analysis System only to teach the system elements discussed above, which does not address the deficiencies of JOHNSON. Therefore, no proper combination of JOHNSON and

the New Hampshire Tax Policy Analysis System teach or suggest the subject matter of claims 1, 8, 11 and 13.

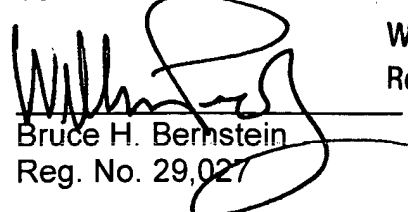
With regard to claims 2-5, 9-10, 12 and 14, Applicant asserts that they are allowable at least because they depend from independent claims 1, 8, 11 and 13, respectively, which Applicant submits has been shown to be allowable.

In view of the herein contained amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of each of the previously asserted rejections set forth in the Official Action of May 3, 2006, together with an indication of the allowability of all pending claims, in due course. Such action is respectfully requested and is believed to be appropriate and proper.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attached thereto.

Should the Examiner have any questions concerning this Reply or the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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